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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,631	10/17/2003	Teruaki Itoh	160-392	8912
23117	7590	03/28/2006	EXAMINER	
NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203			WALLENHORST, MAUREEN	
			ART UNIT	PAPER NUMBER
			1743	
DATE MAILED: 03/28/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/686,631	<b>Applicant(s)</b> ITOH, TERUAKI	
	<b>Examiner</b> Maureen M. Wallenhorst	<b>Art Unit</b> 1743	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 January 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-3 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 4-5 of copending Application No. 10/766,883. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1 and 4-5 of application serial no. 10/766,883 recite each of the features in claims 1-3 of the instant application including a plurality of centrifuge units that are vertically stacked one on another, a rack conveyor, and a rack elevator, wherein the conveyor serves to convey specimen containers horizontally to the stack of centrifuge units, and the elevator serves to carry the specimen containers vertically from the conveyor to the different stacked centrifuge units.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takeda (JP 2000-84436, submitted in the Information Disclosure Statement filed on October 17, 2003) in view of Miller, Muszak et al and Hubert et al.

Takeda et al teach of a centrifugal separator for performing the centrifugation of a liquid sample in a container. The separator comprises a plurality of rotors or centrifuges 10, 12 which each accommodate a plurality of buckets that hold multiple specimen containers. The apparatus also comprises a rack conveying mechanism 14 that transports a rack holding several specimen containers. The conveying mechanism 14 is provided along a horizontal conveyance line that passes by the centrifuge rotors. A tube transfer mechanism 16 transfers a container between the rack and a bucket on one of the rotors and between a bucket and the rack. The rotors are

independently controlled by a controller to operate simultaneously or selectively in a given rotation direction. See Figure 1 in Takeda. Takeda fails to teach that the centrifuge rotors 10, 12 can be vertically stacked upon one another, fail to teach of a rack elevator for vertically transporting the racks containing specimen tubes to and from the vertically stacked rotors, and fail to teach that the tube transfer mechanism 16 is a robotic arm device.

Miller teaches of a rotor incubator assembly useful in a clinical analyzer comprising a plurality of rotationally driven rotors 52 and 54 vertically stacked one on top of the other. The rotors are independently driven, and contain stations evenly spaced about the circumference for accommodating sample slides. Miller teaches that such a configuration for the rotors reduces the space or area required for the analyzer without reducing the effective throughput of the analyzer. See Figure 4, lines 44-67 in column 1, lines 61-67 in column 2 and lines 1-20 in column 3 of Miller.

Muszak et al teach of an analyzer elevator assembly for delivering sample containers or slides to one of multiple incubator rotors disposed at different vertical levels. The rotors contain multiple sites disposed circumferentially for supporting specimen containers. The elevator contains means for lowering or raising a support holding multiple specimen containers to the different levels of the vertically stacked rotors. A pusher is also present on the elevator for pushing test elements from the elevator support to the rotors and from the rotors to the elevator support. See Figure 2, lines 64-68 in column 2 and lines 20-46 in column 7 of Muszak et al.

Based upon the combination of Takeda and Miller, it would have been obvious to one of ordinary skill in the art at the time of the instant invention to vertically stack the centrifuge rotors taught in the centrifugal separator of Takeda, similar to the vertically stacked rotors disclosed by

Art Unit: 1743

Miller, so as to provide a savings in space without reducing the effective throughput of the centrifugal separator, as taught by Miller. When the multiple rotors in the centrifugal separator taught by Takeda are arranged vertically, it also would have been obvious to one of ordinary skill in the art to provide a rack elevator, similar to the elevator assembly taught by Muszak et al, for transporting the racks in a vertical direction so as to deliver the racks to and from the vertically spaced rotors in an efficient manner, as taught by Muszak et al.

Hubert et al teach of an automated centrifuge loading and unloading device in the form of a robot arm. The device serves to pick up sample tubes moving along a conveyor line, place them in centrifuge racks or adaptors 14, transport the adaptors 14 from a staging area 40 to a centrifuge 16, and vice versa. A robotic arm 18 has both a container tube gripper 20 for picking up individual test tubes moving along a conveyor, and an adaptor or rack gripper 22 for picking up specimen adaptor racks 14 and transporting them to buckets on the centrifuge. Hubert et al also teach that a cabinet 16 encloses the centrifuge. See Figures 1, 2B, 2B and 5, lines 20-58 in column 2, lines 50-67 in column 3 and lines 40-66 in column 4 of Hubert et al.

Based upon the combination of Takeda and Hubert et al, it would have been obvious to one of ordinary skill in the art to form the tube transfer mechanism 16 in the centrifugal separator taught by Takeda as a robotic arm, similar to the robotic arm structure disclosed by Hubert et al, since Hubert et al teach that such a robotic arm device enables both individual tubes and racks holding multiple tubes to be automatically picked up and delivered into a centrifuge for processing in a quick and efficient manner. It also would have been obvious to one of ordinary skill in the art to enclose the plurality of centrifuge rotors in the device taught by Takeda in sealed cabinets, similar to the cabinet 16 in which the centrifuge taught by Hubert et al is located,

Art Unit: 1743

so as to avoid any splattering or spilling of the samples in the containers to the outside environment during centrifugation.

7. Applicant's arguments filed January 23, 2006 have been fully considered but they are not persuasive.

Applicant argues the rejection of the claims under 35 USC 103 as being obvious over Takeda in view of Miller, Muszak et al and Hubert et al made in the last Office action mailed on September 22, 2005 by stating that in both Miller and Muszak et al, slide test elements are loaded and unloaded from incubators by a pusher, and that one of ordinary skill in the art would not have been motivated to utilize a robot arm with an elevator assembly for the test slides since such an arm would have difficulty grasping and maneuvering slides. In response to this argument, it is noted that Applicant is arguing the structure taught by the secondary references, not by the primary reference. The rejection under 35 USC 103 is not based upon using a robot arm to move the slides taught by the secondary references to Miller and Muszak et al. Rather, Takeda is the primary reference, and the rejection is based upon modifying the multiple, horizontally located centrifuge units taught by Takeda into a vertical stack, as taught by Miller and Muszak, and transporting the specimen tubes located in the racks taught by Takeda with a robot arm, such as that taught by Hubert et al.

Applicant argues that the elevator assembly taught by Muszak would not benefit from a robot arm mounted thereon, and that the robot arm 18 taught by Hubert is already mounted above the centrifugal station 10, and therefore, is not required to be raised or lowered via an elevator. In response to these arguments, it is noted that the rejection is not based upon placing a robot arm onto the elevator taught by the secondary reference to Muszak et al. Rather, the

Art Unit: 1743

primary reference to Takeda already teaches of some type of robot arm 16 that transfers the specimen tubes between a rack on a conveyor and a bucket on one of the centrifuge units. The rejection under 35 USC 103 is based upon placing this robot arm 16 in Takeda on an elevator when the centrifuge units taught by Takeda are stacked vertically, as per the teaching of Miller to save space in an analyzer without reducing its effective throughput, so that the robot arm 16 can reach each of the centrifuge units. With regards to the Hubert et al patent, it is noted that two robot arms 20, 22 are mounted to a shaft 18, and the arms 20 and 22 are raised and lowered on the shaft 18 in order for the arms to reach the tubes 12 on the centrifuge 10. Therefore, contrary to Applicant's argument, the robot arms 20, 22 taught by Hubert et al are raised and lowered by an elevator mechanism.

Applicant argues that claim 1 now recites that the rack elevator is provided at a side of the centrifuge units, and this structure is lacking in the references. In response to this argument, it is noted that the elevator 100 taught by Muszak et al is located at the side of the centrifuge rotors 36 and 40. See Figure 2 in Muszak.

Applicant argues that the applied references fail to teach a cabinet provided in layers for holding individual centrifuge units, and fail to teach of the cabinet having a window therein through which a robot arm can load specimen containers into the centrifuge units. In response to these arguments, it is noted that the secondary reference to Miller teaches to stack multiple centrifuge rotors in an apparatus vertically for the advantage of reducing the space or area required for the analyzer, and Hubert et al teach to enclose a centrifuge unit into a cabinet in order to avoid any splattering or spilling of samples to the outside environment during centrifugation. Therefore, it would have been obvious to one of ordinary skill in the art at the



Art Unit: 1743

time of the instant invention to vertically stack the centrifuge rotors taught in the centrifugal separator of Takeda, similar to the vertically stacked rotors disclosed by Miller, so as to provide a savings in space without reducing the effective throughput of the centrifugal separator, as taught by Miller. In addition, the cabinet 16 taught by Hubert et al includes window or opening on the top thereof through which the robot arms 20, 22 can insert the tubes 12 and racks 14 through. See Figure 1 in Hubert et al. Therefore, it would have been obvious to one of ordinary skill in the art to enclose the plurality of centrifuge rotors in the device taught by Takeda in individual sealed cabinets having windows or openings therein, similar to the cabinet 16 in which the centrifuge taught by Hubert et al is located, so as to avoid any splattering or spilling of the samples in the containers to the outside environment during centrifugation.

For all of the above reasons, Applicant's arguments are not found persuasive. This Office action is not being made final since a new ground of rejection under the judicially created doctrine of obviousness type double patenting has been made.

Art Unit: 1743

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maureen M. Wallenhorst whose telephone number is 571-272-1266. The examiner can normally be reached on Monday-Wednesday from 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden, can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Maureen M. Wallenhorst  
Primary Examiner  
Art Unit 1743

mmw

March 23, 2006

*Maureen M. Wallenhorst*  
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